

REMARKS

Claims 1-15, 17-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirani et al. (U.S. patent application 2002/0016818A1) and further in view of Beyda (U.S. patent 56,870,610).

Regarding independent claims 1, 19, 27 and 28 the Examiner's interpretation of the description of Kirani et al. and Beyda patents needs further clarification in order to distinguish the present invention from these references.

MPEP paragraph 2143 states:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Regarding independent claim 1 of the present invention, the Examiner does not show that the references he quoted contain all the claim limitations as required by the third criterion (prior art references when combined must teach or suggest all the claim limitations) of the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

In particular, the Examiner alleges that Kirani et al. teaches the first step of claim 1:

"providing (54) a multimedia messaging service signal (20)

incorporating a further multimedia message signal (FMMS) indicative of a multimedia message and a terminal-specific uniform resource locator (URL) signal from a multimedia messaging service center (14) to a receiving terminal (22), said URL signal providing an internet server (32) location of software obtainable by the receiving terminal (22);"

Kirani et al. describe a methodology for optimizing delivery of e-mail attachments to wireless handheld devices. According to Kirani et al. (e.g., see Abstract; and page 8, [0103]), a detached attachment is saved in a network media-sharing repository, and can be subsequently accessed via a link (e.g., URL) referencing the storage address. But the difference with the present invention is that Kirani et al. provides said URL (contained in the e-mail message) for retrieving said attachment, whereas, according to claim 1 of the present invention, said URL signal provides an internet server (32) location of software obtainable by the receiving terminal (22) for rendering said multimedia message. Kirani et al. does not talk, describe or even hint about obtaining any additional software to be installed in the receiving terminal for rendering said attachment. Thus, Kirani et al. does not teach the limitation of claim 1 of the present invention related to using the URL signal for providing an internet server (32) location of software obtainable by the receiving terminal (22) for rendering said multimedia message. Therefore, combination of Kirani et al. and Beyda (combining Kirani et al. teaching with Beyda's concept of automatic software downloading) do not teach all the claim limitations as required by the third criterion of the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

Even if, for the sake of argument only, we assume that the Examiner is correct alleging that the two references (Kirani et al. and Beyda) he recites describe all of the limitations of

independent claim 1 of the present invention, it can be argued that the Examiner does not show that the references he quoted contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings without the benefit of hindsight as required by the first criterion of MPEP paragraph 2143, quoted above. Indeed, none of the cited references suggests, discusses or even hints explicitly or implicitly about the fundamental problem which is solved by the present invention: *providing terminal-specific uniform resource locators (URLs) of downloadable software to a receiving terminal allowing said receiving terminal to render originally unsupported components of multimedia messages, wherein the URLs are provided (along with said multimedia message) to the receiving terminal by a multimedia messaging service center (MMSC) which identifies the URLs from its database using information on the receiving terminal capabilities (i.e. based on terminal model and software release) and possibly multipurpose internet mail extension (MIME) types of originally unsupported components in multimedia messages sent to said receiving terminal.*

Moreover, Kirani et al. and Beyda do not provide teaching or suggestion for the reasonable expectation of success for the present invention recited in claim 1 by using the combination of Kirani et al. teaching with Beyda's concept of automatic software downloading (simply because none of the present references discuss or even hint about the present invention as discussed above), as absolutely required by the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

The above considerations obviate the Examiner's 103(a) rejection of claim 1.

The above considerations regarding claims 1 are also applied

to independent claims 19, 27 and 28 as well, which are similar in scope to claim 1.

The applicant further respectfully disagrees with the Examiner's arguments for rejecting dependent claims 2-15, 17-18, 20-26 under 35 U.S.C. 103(a) as being unpatentable over Kirani et al. and further in view of Beyda.

First, claims 2-15, 17-18, 20-26 are dependent claims (directly or indirectly) of independent claims 1 or 19, respectively. Independent claims 1 or 19 are novel and not anticipated by Kirani et al. in view of Beyda. Since each of the dependent claims 2-15, 17-18, 20-26 narrows the scope of novel and non-obvious independent claims 1 or 19, non-obviousness of claims 1 or 19 will compel non-obviousness of claims 2-15, 17-18, 20-27. Therefore, claims 2-15, 17-18, 20-26 are not anticipated by Kirani et al. in view of Beyda under 35 USC 103(a).

Furthermore, many specific limitations of claims 2-15, 17-18, 20-26 are not described by Kirani et al. or by Beyda or by a combination thereof, as alleged by the Examiner, because most of these additional limitations reference the URL signal containing "an internet server (32) location of software obtainable by the receiving terminal (22)" which is not taught explicitly or implicitly by Kirani et al., as elaborated above. Indeed, Kirani et al. (see page 3, [0037]) describe different URL's: "The recipient may receive a link (e.g., URL), that references the storage address in the network repository, for the original (e.g., full-resolution) attachment for subsequent accessing from a more capable client device. The recipient may receive a link for the reformatted attachment for subsequent processing/consuming from the current client device." However, none of these URLs recited by Kirani et al. describe internet

server (32) location of software obtainable by the receiving terminal (22) as recited in the present invention.

Withdrawal of the 35 U.S.C. 103(a) rejection of claims 1-15, 17-28 is requested.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirani et al. (U.S. patent application 2002/00168181A1) and Beyda (U.S. patent 6,870,610) in further in view of Sollee et al. (U.S. patent 6,757,732).

Since claim 16 is a dependent claim of independent claims 1, which is, as shown above, is novel and not anticipated by Kirani et al. in view of Beyda or by Kirani et al. in view of Beyda and Sollee et al. (the latter is not shown by the Examiner), claim 16 narrows the scope of novel and non-obvious independent claim 1, and, therefore, non-obviousness of claim 1 will compel non-obviousness of claim 16. Thus, claim 16 is not anticipated by Kirani et al. and Beyda in view of Sollee et al. under 35 USC 103(a).

Withdrawal of the 35 U.S.C. 103(a) rejection of claim 16 is requested.

The objections and rejections of the Official Action of November 24, 2004 having been obviated or shown to be inapplicable, withdrawal thereof is requested, and passage of the claims to issue is earnestly solicited.

Respectfully submitted,



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